

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS RODERICK CHISHOLM,
and ANDREW BOYCE MCNEILL, JR.

Appeal No. 1997-3239
Application 08/312,854

ON BRIEF

Before BARRETT, FLEMING, and GROSS, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 and 3 through 6, all of the claims pending in the present application. Claim 2 has been canceled.

The invention relates to a high performance serial cable bus having automatic acyclic configuration devices in a star configuration with dual controllers, and a switching device

from one controller domain to the other controller domain
during a failure mode.

Independent claim 1 is reproduced as follows:

1. In a high speed acyclic serial bus having a plurality of devices, each device having a plurality of communication ports, a system for providing redundant access to said devices comprising:

a first concentrator having a plurality of ports, one of said ports being connected to a first communications port of said plurality of communication ports on each of said plurality of devices;

a second concentrator having a second plurality of ports, one of said ports of said second plurality of ports being connected to a second communications port of said plurality of communication ports on each of said plurality of devices;

first means for enabling a portion of said first plurality of ports for accessing a corresponding portion of said plurality of devices through said first concentrator; and

second means for enabling a second portion of said plurality of ports through said second concentrator for accessing a second portion of said plurality of devices not accessed by said first concentrator; and

further comprising complementary first and second signals, said first signal being used to activate said first enabling means and said complementary second signal being used to activate said second enabling means such that each of said plurality of devices is only access by one concentrator.

The Examiner relies on the following references:

Appeal No. 1997-3239
Application 08/312,854

Oprescu	5,394,556	Feb. 28,
1995		
Van Brunt et al. (Van Brunt)	5,424,657	June
13, 1995		

"IEEE Standard for a High Performance Serial Bus," The
Institute of Electrical and Electronic Engineers, Inc., Draft
7.1v1, IEEE P1394, August 5, 1994. (Hereinafter IEEE).

Applicants' admitted prior art, Spec. pp. 3 and 6, Figs. 1-5.
(Hereinafter Appellants' admitted prior art).

Appeal No. 1997-3239
Application 08/312,854

Claims 1 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Appellants' admitted prior art in view of IEEE.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Appellants' admitted prior art in view of IEEE and Van Brunt.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Appellants' admitted prior art in view of IEEE and Oprescu.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1 and 3 through 6 under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or

Appeal No. 1997-3239
Application 08/312,854

suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6
(Fed. Cir. 1983). "Additionally, when determining
obviousness,

the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-Ordinance Mfg. v. SGS Importers Int'l, Inc.**, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 519 U.S. 822 (1996), **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

Appellants argue that the references relied on by the Examiner fail to expressly teach or suggest complementary first and second signals, said first signal being used to activate said first enabling means and said complementary second signal being used to activate said second enabling means, such that each of the plurality of devices is only accessed by one controller as recited in Appellants' claim 1. Appellants argue that this arrangement, as described in the specification on page 12, line 22, allows for maintaining an acyclic star configuration without creating loops, such as those depicted within Fig. 5, so that initialization may occur. In particular, Appellants argue that patterns within the shift registers may be utilized to supply TpBias to only

one of the common disk drive ports such that the common disk drivers may initialize while only one port is logically connected, maintaining an acyclic star configuration without creating loops. See page 5 of Appellants' brief.

In response, the Examiner argues on pages 3 and 4 of the answer that IEEE teaches that redundant paths are a good thing. The Examiner states that it would have been therefore motivating to one of ordinary skill in the art to create more than one path to the devices for reliability purposes. The Examiner then states that the duplicating of the paths would include duplicating the concentrator.

Upon our review of IEEE, we fail to find any teaching or suggestion of a high speed acyclic serial bus in which there are

"complementary first and second signals, said first signal being used to activate said first enabling means and said complementary second signal being used to activate said second enabling means such that each of the plurality devices is only accessed by one concentrator"

as recited in Appellants' claim 1. Furthermore, we fail to find that Van Brunt or Opreescu suggests or teaches the complementary signals which may be utilized to selectively

Appeal No. 1997-3239
Application 08/312,854

activate only selected devices for each concentrator having a
redundant path in a manner set forth in Appellants' claims.

Appeal No. 1997-3239
Application 08/312,854

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a **prima facie** case. **In re Piasecki**, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); **In re Knapp-Monarch Co.**, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); **In re Cofer**, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Furthermore, Our reviewing court states in **In re Piasecki**, 745 F.2d at 1472, 223 USPQ at 788, the following:

The Supreme Court in **Graham v. John Deere Co.**, 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under section 102 and 103". **Citing In re Warner**, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967).

Appeal No. 1997-3239
Application 08/312,854

In view of the foregoing, we have not sustained the rejection of claims 1 and 3 through 6 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge))	
)	
)	
MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
)	
ANITA PELLMAN GROSS)	
Administrative Patent Judge))	

MRF/dal

Appeal No. 1997-3239
Application 08/312,854

ANDREW J. DILLON
FELSMAN, BRADLEY, GUNTER
and DILLON, LLP
STE. 350
LAKEWOOD ON THE PARK
7600B NORTH CAPITAL OF TEXAS HIGHWAY
AUSTIN, TX 78731